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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,034	03/16/2001	Kazunobu Konda	P 279136 T4KM-00S1177-1	5592
909 7590 05/03/2004 PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER KNOLL, CLIFFORD H	
			ART UNIT 2112	PAPER NUMBER

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/809,034

Applicant(s)

KONDA ET AL.

Examiner

Clifford H Knoll

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-- The MAILING DATE of this communication appears n th c ver sheet with the correspondenc address --
Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.7.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 3/16/2001, and entered as paper 4, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-15 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claimed memory is directed to non-functional, inoperative subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 8, 9-15, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3, 8, 9-11, and 20, the "high priority" is unclear, because it is not clear what relationship is intended to other elements of the claim, nor is it clear, if one is to infer "high" in relative terms, as to what priority is being asserted.

Although these claims all recite first and second modes adequately, lack of a relationship between them in the recitation mean that they are interpreted broadly in rejection infra.

In claims 12-15, the "method ... written in firmware" is unclear because the means to write a method is not clear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-12, 14-16, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura (US 2001/0051930).

Regarding claim 1, Nakamura discloses a function of setting a method of using the IEEE 1394 serial bus (e.g., paragraph [0005], "device that operates").

Regarding claim 2, Nakamura also discloses where the method of using the bus comprises indicating whether to permit or inhibit control from the remote device (e.g., paragraph [0010], "controlling the ... device through the network in the operation range that has been assigned").

Regarding claim 3, Nakamura also discloses wherein the method setting comprises a first user setting of giving a high priority to operation of said self-device (e.g., paragraph [0145], "local DCM") and a second user setting of accepting operation from the remote device as well (e.g., paragraph [0145], "remote DCM").

Regarding claim 4, Nakamura also discloses wherein in the first user setting, said self-device returns rejected responses to all operation commands from the remote device (e.g., paragraph [0131]).

Regarding claim 5, Nakamura also discloses wherein in the first user setting, said self-device can turn off a power supply of an internal device of said self-device and also turn off a power supply of the IEEE 1394 interface or switch the IEEE 1394 interface to an inactive state (e.g., paragraph [0120], "power on/off control").

Regarding claim 6, Nakamura discloses a digital video apparatus incorporating an IEEE 1394 interface to which a remote digital device can be connected through IEEE

1394 serial bus (e.g., paragraph [0094]), comprising a function of setting whether to permit or inhibit control from the remote digital device as a method of using the IEEE 1394 serial bus (e.g., paragraph [0010]).

Regarding claim 7, Nakamura discloses wherein said function is written as predetermined device control firmware in a memory, and the memory (e.g., paragraph [0098]), and a video display apparatus constitute a digital television apparatus (e.g., paragraph [0094]).

Regarding claim 8, Nakamura discloses in the first mode, causing the self-device to reject a control command supplied from the remote device; and in the second mode, causing the self-device to perform processing corresponding to a control command supplied to the self-device (e.g., paragraph [0131]).

Regarding claim 10, Nakamura discloses registering a predetermined remote device of the remote devices; in the first mode, causing the self-device to reject a control command supplied from the remote device; in the second mode, if the control command is not a command from the predetermined registered remote device, causing the self-device to reject the control command supplied from the remote device; and in the second mode, if the control command is a command from the predetermined registered remote device, causing the self-device to perform processing corresponding to the supplied control command (e.g., paragraph [0131]).

Regarding claim 11, Nakamura discloses registering a predetermined remote device of the remote devices; in the first mode, if the control command is not a command from the predetermined registered remote device, causing the self-device to

reject the control command supplied from the remote device (e.g., paragraph [0131]); in the first mode, if the control command is a command from the predetermined registered remote device, causing the self-device to perform processing corresponding to the control command supplied from the remote device (e.g., paragraph [0120]); and in the second mode, causing the self-device to perform processing corresponding to a supplied control command (e.g., paragraph [0120]).

Regarding claim 12, Nakamura discloses a memory in which the method defined in claim 8 is written as firmware (e.g., paragraph [0098]).

Regarding claim 14, Nakamura discloses memory in which the method defined in claim 10 is written as firmware (e.g., paragraph [0098]).

Regarding claim 15, Nakamura discloses memory in which the method defined in claim 11 is written as firmware (e.g., paragraph [0098]).

Regarding claim 16, Nakamura discloses a digital broadcast reception apparatus using the method defined in claim 8 (e.g., paragraph [0094]).

Regarding claim 18, Nakamura discloses a digital broadcast reception apparatus using the method defined in claim 10 (e.g., paragraph [0094]).

Regarding claim 19, Nakamura discloses a digital broadcast reception apparatus using the method defined in claim 11 (e.g., paragraph [0094]).

Regarding claim 20, Nakamura discloses wherein the self-device has a first mode of giving a high priority to control on the self-device, and a second mode of accepting control from the remote device, in the first mode, the self-device rejects a control command supplied from the remote device, and in the second mode, the self-

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device performs processing corresponding to a supplied control command (e.g., paragraph [0131]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of the IEEE 1394 standard, as evidenced by Fuller ("Architecture for power management on high speed serial bus").

Regarding claim 9, Nakamura discloses in the modes, causing the self-device to control power modes of the IEEE1394 device (e.g., paragraph [0120]), but neglects to mention the particular power modes provided for by the IEEE1394 standard; however, these modes are well-known in the art and commonly practiced as part of the IEEE1394 standard, as evidenced by Fuller. Fuller discloses turning off a power supply in a high priority first mode (e.g., p. 9, Table, "D1"), and a second mode causing the self-device to turn off a power supply of an internal device of the self-device without turning off a power supply of the IEEE 1394 interface (e.g., p. 10, Table 2, "H2"). It would be obvious to combine the power control provisions of the IEEE 1394 standard with

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Nakamura power control modes, because it is clearly advantageous to practice the standard known at the time when implementing its power mode provisions in a system that uses the standard. Therefore it would have been obvious at the time the invention was made to combine the IEEE 1394 standard with Nakamura to obtain the claimed invention.

Regarding claim 13, Nakamura discloses memory in which the method defined in claim 9 is written as firmware (e.g., paragraph [0098]).

Regarding claim 17, Nakamura discloses a digital broadcast reception apparatus using the method defined in claim 9 (e.g., paragraph [0094]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zou (US 6694349) discloses remote and self-device control (e.g., col. 3, lines 23-42).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clifford H Knoll whose telephone number is 703-305-8656. The examiner can normally be reached on M-F 0630-1500.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H Rinehart can be reached on 703-305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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